



30 AUG 2007

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In re Application of	:	
PHILLIPS, et al.	:	
U.S. Application No.: 10/582,617	:	DECISION ON PETITION
PCT No.: PCT/AU04/01749	:	
Int. Filing Date: 13 December 2004	:	UNDER 37 CFR 1.497(d)
Priority Date: 11 December 2003	:	
Attorney Docket No.: 207,643	:	
For: HIGH IMPACT GATE	:	

This decision is in response to applicant's "Petition to Add Inventor Under 37 CFR 1.497(d)" filed 23 July 2007 in the United States Patent and Trademark Office (USPTO).

### **BACKGROUND**

On 13 December 2004, applicant filed international application PCT/AU04/01749 which claimed priority to an earlier application filed 11 December 2003. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 23 June 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 11 June 2005.

On 10 June 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee and a first preliminary amendment.

On 02 April 2007, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 23 June 2007, applicant responded with the present petition accompanied by a petition for a two-month extension of time and payment of the appropriate extension of time fee. With the payment of the extension of time fee, the present response is considered timely filed.

### DISCUSSION

37 CFR 1.497(d) [formally, 37 CFR 1.48] states in part: "If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application....applicant must submit:

- (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) the fee set forth in 37 CFR 1.17(h); and
- (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b); and
- (4) any new oath or declaration required by paragraph (f) of this section.

Applicant has satisfied items (1), (2) and (4). Specifically, the inventor being removed has signed a statement indicating that his inclusion in the international application was in error and without deceptive intent. In addition, applicant has provided a compliant declaration of the actual inventor and authorized payment of the petition fee to deposit account number 23-2185.

Regarding item (3), while applicant has included a statement from the assignee consenting to the correction of inventorship in the application, the statement in and of itself is insufficient for satisfying this item. As explained in the Manual of Patent Examining Procedure section 201.03:

The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record. A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent. However, if it appears in another paper of record, e.g., small entity assertion, it is also acceptable. Further, the assignee must establish its ownership of the application in accordance with 37 CFR 3.73. MPEP § 324.

The filed paper shows that Mr. Phillips is the director of EZI Automation Pty Ltd., but does not indicate that he has the authority to act on behalf of the assignee and his title has not been made of record. In addition, the assignee has not established its ownership in accordance with 37 CFR 3.73.

In light of the above, it is not possible to grant applicant's petition at this time.

### CONCLUSION

For the reasons above, applicant's request under 37 CFR 1.497(d) is **DISMISSED**

without prejudice.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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